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27386	7590	09/03/2010	EXAMINER	
GERSTENZANG, WILLIAM C. NORRIS MC LAUGHLIN & MARCUS, PA 875 THIRD AVE, 8TH FLOOR NEW YORK, NY 10022			DESAI, ANISH P	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

1. Continuation of Box 5:

2. The 112-second paragraph rejections as set forth in the Final Office action (FOA) mailed on 05/25/10 are withdrawn after reviewing applicant's amendment.

3. Continuation of Box 11:

4. With respect to the 103(a) rejections based on Wallner (US 3,146,882) in view of Akhter (US 5,958,537), and as evidenced by Roeder (US 3,672,371), on pages 4-8 of the after-final (AF) amendment, applicant essentially argues that given that Akhter teaches addition of conductive particles in the adhesive layer and the primer layer, one of ordinary skill in the art reviewing Akhter would understand that the conductive primer layer would have to be in contact with the conductive adhesive layer in order for the electrical charge to be conducted out of the film. According to applicant, one would not be motivated to add the conductive particles of Akhter in the primer layer of Wallner without adding the particles in the adhesive layer of Wallner.

5. The Examiner respectfully disagrees. It appears that applicant is reviewing Akhter's teaching and assuming that like Akhter, Wallner is also attempting to transfer conductive charge out of the adhesive tape. However, at column 1 lines 10-25, Wallner discloses "This invention relates to an improvement in prior pressure-sensitive adhesive tape of the type which has a thin hydrophobic film backing coated with an aggressively tacky water-insoluble viscoelastic...such prior type of tape is electrically insulating as to

all layers. When such length of tape is unwound from the roll and severed, the resultant piece of tape is found to be electrostatically charged..." Additionally, at column 1 lines 27-31, Wallner discloses "It has been unexpectedly discovered that this static propensity can be overcome by utilizing a thin antistatic primer coating (located between the backing film and the adhesive layer) which is so compounded to have substantial electrical conductivity..." Further, Wallner clearly teaches that "Incorporation of antistatic agent in the adhesive composition will result in an inferior adhesive" (column 1 lines 55-60). Based on this, it is respectfully submitted that Wallner is not necessarily attempting to transfer conductive charge out of the adhesive tape (i.e. by establishing electrically conductive path between the electrically conductive primer and electrically conductive adhesive).

6. Further, it is submitted that the function of Wallner's antistatic polymers and Akhter's electrical particles is same, namely to dissipate electrical charge (column 1 lines 25-40 and column 2 lines 55-60 of Wallner, column 1 lines 5-10 and column 3 lines 5-10 of Akhter). Additionally, Wallner already makes clear to one of ordinary skill in the art that incorporation of antistatic agent in the adhesive will result in inferior adhesive (see column 1 lines 55-59). As such since Wallner is the primary reference being modified, one of ordinary skill in the art who is in possession of Wallner recognizes that Wallner does not desire addition of antistatic agents (i.e. inorganic polymer of Wallner or conductive particles) in the adhesive. Based on this, the Examiner respectfully submits that while Akhter may teach of adding conductive particles (antistatic agent) in both the

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primer layer and the PSA layer, one of ordinary skill in the art recognizes not to add conductive particles of Akhter in the PSA of Wallner. It is submitted that it is *prima facie* obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose... [T]he idea of combining them flows logically from their having been individually taught in the prior art (see MPEP 2144.06). As such, applicant's arguments are not found persuasive.

7. On page 8 of the amendment (last full paragraph), applicant argues that addition of conductive particles in Wallner would interfere with the transparency of the adhesive tape, because a primer loaded with conductive particles would be expected by those skilled in the art to be less transparent than it would be without such particles.

8. The Examiner respectfully disagrees. It is submitted that the aforementioned arguments are not found persuasive, because they are speculative in nature, without any factual evidence to support the position.

9. As to applicant's arguments on page 9 of the amendment, referring to the Examiner's evidence reference of Roeder, the Examiner respectfully submits following:

10. It is noted that even if one were not to rely on Roeder to show that polyacrylates are elastomeric, it is noted that applicant has stated that the polyacrylates of present invention are viscoelastic systems, which means they are somewhat viscous and

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somewhat elastic at the same time (see last full paragraph on page 9). The Examiner notes that Wallner at column 2 lines 5-11 discloses **viscoelastic PSAs** such as polyacrylates. As such, it is clear that Wallner's and applicant disclose same adhesive, therefore, like applicant's PSA layer; Wallner's PSA layer would intrinsically exhibit shrinkback.

11. On pages 10-13 of the AF amendment, applicant has essentially incorporated same arguments that are presented regarding Wallner and Akhter. In response, the Examiner has nothing more to add but to incorporate his rebuttal as set forth above in this Advisory Action (AA) and on pages 13-14 of the FOA mailed on 05/25/10.

/A. D./

Examiner, Art Unit 1787

/Callie E. Shosho/

Supervisory Patent Examiner, Art Unit 1787